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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,916	02/16/2001	William Grey	101.003	5225
48175	7590	03/08/2006	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			ALPERT, JAMES M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/784,916

Applicant(s)

GREY ET AL.

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 17-30 and 33-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-30 and 33-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The following communication is in response to Applicant's amendment filed on 12/22/2005.

#### ***Status of Claims***

Claims 2-14,18-30,34-46 are original. Claims 1,17,33 are currently amended. Claims 15-16,31-32,47-48 are cancelled. Claims 1-14,17-30,33-46 are, therefore, currently pending.

#### ***Response to Arguments***

**With regard to the rejections under 35 U.S.C. §101**, Applicant's amendments to the claims are sufficient to overcome the rejections, and they are hereby withdrawn.

**With regard to the rejections under 35 U.S.C. §102/103**, Applicant's arguments have been fully considered but they are not persuasive as discussed below. Therefore, Claims 1-14,17-30,33-46 remain rejected as stated in the previous office action, and Applicant's request for allowance is respectfully denied.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-14,17-30,33-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Claims 1,17,33 describe "two or more different desired items" in both the 1<sup>st</sup> and 2<sup>nd</sup> paragraphs of the claim, while the

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3<sup>rd</sup> paragraph mentions a simple "two desired items". It is unclear how the invention will operate if more than two items are desired. Appropriate correction is required.

***Claim Rejections - 35 USC §'s 102/103***

The text of 35 U.S.C and §102 and §103, which are not included in this action, can be found in a prior Office Action.

Claims 1-9,13-14,17-25,29-30,33-41,45-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Preist, U.S. Patent #6892186. Claims 10,26,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preist alone, while Claims 11-12,27-28,42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preist in view of Rackson et al, U.S. Patent #6415270.

The Applicant has amended the claims to recite:

providing an indication of two or more different desired items, only one of which is to be obtained;

identifying a plurality of auctions in which the two or more different desired items are being auctioned; and

automatically submitting, using a processor, one or more bids to a plurality of auctions in order to obtain one of the two desired items.

The Examiner has considered the amendments, and reminds Applicant that claims may be given the broadest reasonable interpretation. See In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Keeping this fact in mind, the Examiner is of the opinion that a reasonable interpretation of the claims as amended is that a user could be seeking one item of a particular make/model or a second item of a particular make/model, with no preference for which one he receives. For example, the user could indicate that he is willing to obtain one Dell Inspiron 6000 Notebook

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Computer offered in one auction, or a second Dell Inspiron 6000 Notebook Computer offered in a second auction. They are clearly different computers, unless the seller has listed one computer in multiple auctions, which violates auction policies generally. He indicates that he desires to obtain only one of the two more different Dell Inspiron 6000 Notebook Computers that is currently available. Thus Applicant's amendments have failed to overcome Preist's methods for obtaining items in multiple auctions.

Applicant should further be on notice that should he amend the claims so as to indicate that "different items" be of different makes and/or models, the amendment would, being an alternative embodiment, require an restriction by original presentation. That is to say, obtaining one of two or more different types/makes of an item is a different species than obtaining only one or multiple lots of only one type of an item.

In any event, the claims as amended, remain rejected as in the first action on the merits, mailed 09/13/2005, and are detailed below.

**With regard to Claims 1, 17, 33,** Preist teaches a method, apparatus, and medium comprising:

providing an indication of two or more different desired items, only one of which is to be obtained; (Col. 21, lines 61-65)

identifying a plurality of auctions in which the two or more different desired items are being auctioned; and (Col. 21, lines 61-65)

automatically submitting, using a processor, one or more bids to a plurality of auctions in order to obtain one of the two desired items. (Col. 22, lines 16-17)

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**With regard to Claims 2, 18, 34,** Preist teaches a method, apparatus, and medium comprising:

identifying one of the plurality of the plurality of auctions having a lowest next bid price for the item, wherein (Col. 22, lines 1-2)

a next bid price in a particular auction for a particular item is based on a sum of a current bid price for the particular item in the particular auction and a minimum bidding increment associated with the particular auction. (Col. 22, lines 4-8)

**With regard to Claims 3, 19, 35,** Preist teaches a method, apparatus, and medium comprising:

determining whether the lowest next bid price is greater than a maximum bid price; and, (Col. 13, lines 20-29)

if it is determined that the lowest next bid price is not greater than the maximum bid price, submitting to the one auction a bid for the item, the bid being based on the lowest next bid price. (Col. 13, lines 20-29)

**With regard to Claims 4, 20, 36,** Preist teaches a method, apparatus, and medium comprising:

determining whether the lowest next bid price is greater than a maximum bid price; (Col. 13, lines 20-29)

and, if it is determined that the lowest next bid price is greater than a maximum bid price, presenting an indication that the lowest next bid price is greater than the maximum bid price and determining another maximum bid price greater than the lowest next bid price. (Col. 13, lines 20-29)

**With regard to Claims 5, 21,37,** Preist teaches a method, apparatus, and medium comprising:

determining that a submitted bid has been surpassed; and automatically submitting another bid to at least one of the plurality of the plurality of auctions in order to obtain the item. (Col. 14, lines 61-65)

**With regard to Claims 6-8, 22-24,38-40**, Preist teaches a method, apparatus, and medium designed such that upon determining that active bidding has been surpassed, the process of determining the appropriate bidding strategy based on the next lowest bid(s) is repeated. This being the case, the entire procedure ,as laid out in the above enumerated claims, are performed in a looped manner, and anticipate said claims.

**With regard to Claims 9, 25, 41**, Preist teaches a method, apparatus, and medium comprising:  
withdrawing a previously-submitted bid. (Col. 15, lines 15-25)

**With regard to Claims 13, 29, 45**, Preist teaches a method, apparatus, and medium wherein:  
the maximum bid price is based on market factors.

This is an inherent part of the process in Preist. Each determination of maximum bid price will be based on market factors, that is external factors influencing price, as well as individual factors, which include the bidder's real desire for an item.

**With regard to Claims 14, 30, 46**, these claims relate to the various scenarios where one or more bids is placed for one or more of the same unit, which is redundant in view of Claim 1. The processes in Preist deal with the variety of scenarios contemplated by these claims, in that Preist can be performed with multiple lots or single lots, and in single auctions or multiple auctions. Thus Preist anticipates these claims as well.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10,26,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preist, U.S. Patent #6892186. Claims 11-12,27-28,42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preist in view of Rackson et al, U.S. Patent #6415270.

**With regard to Claims 10, 26, 42,** Preist does not expressly teaches the method, apparatus, and medium comprising:

determining that the bid price of the previously-submitted bid is greater than a sum of a next bid price of one of the plurality of auctions and a cost to withdraw the previously-submitted bid.

However, the examiner takes official notice that withdrawing a bid based on the cost of withdrawing the bid in consideration of the next bid price is old and well known. As such, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made, given the analysis throughout Preist, which focuses on incremental bidding, to modify Priest to include a withdrawal consideration based on cost. The motivation for such a modification is to reduce the cost of an analysis by including a withdrawal consideration in the next lowest bid process, as opposed to a separate analysis as it currently stands. This would save time and money.



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Further, MPEP § 2144.03(C) states, in respect to an Examiner's use of Official Notice:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b).

The same section continues:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Applicant has not traversed the Examiner's use of official notices, and as such, the Examiner is now obligated to consider as admitted prior art, the elements of Claims 10,26,42.

**With regard to Claims 11, 27, 43,** Preist does not expressly teaches the method, apparatus, and medium comprising:

analyzing at least one of group bidding history and individual bidding history.

However, Rackson does teach this limitation at (Col. 23, lines 6-17). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Preist, relating to the process of considering incremental bidding to in order obtain one or more items from one or more auctions, with the teachings of Rackson, relating to the consideration of individual and group bidding history in determining a bid amount. The motivation for such a combination is to include as many variables as possible in determining a certain value will be successful in any randomly selected auction, and further considering timing of auctions. This is suggested in many places in Preist including (Col. 16, lines 1-3).

**With regard to Claims 12, 28, 44,** Preist does not expressly teaches the method, apparatus, and medium wherein:

automatically submitting one or more bids comprises: analyzing at least one of a bidding history for an item similar to the item, a bidding history for items complementary to the item, and a bidding history for items substitutable for the item.

However, Rackson does teach this limitation at (Col. 24, lines 31-51). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Preist, relating to the process of considering incremental bidding to in order obtain one or more items from one or more auctions, with the teachings of Rackson, relating to the consideration of the bidding history in relation to the type of item being auctioned. The motivation for such a combination is to include as many variables as possible in determining a certain value will be successful in any randomly selected auction(s), and further considering timing of an auction(s). This is suggested in many places in Preist including (Col. 16, lines 1-3).

### ***Conclusion***

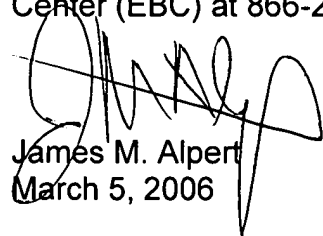
THIS ACTION IS FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (571) 272-6738. The examiner can normally be reached on M-F 9:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

  
James M. Alpert  
March 5, 2006



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